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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/575,195 | 05/23/2000 | Kia Silverbrook | NPA002US | 9147 |
| 24011 | 7590 | 04/06/2005 | EXAMINER | |
| SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA | | | HEWITT II, CALVIN L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3621 | |

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/575,195

Applicant(s)

SILVERBROOK ET AL.

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Status of Claims

1. Claims 1-59 have been examined.

Response to Amendment/Argument

2. One of ordinary skill in electronic commerce is familiar with purchasing goods and services over the internet using a webpage. One of ordinary skill, in light of the clear teachings of Buckley et al., would also be apprised of making an online purchase using a pen. Specifically, Buckley et al. teach scanning a form with a pen, storing scanned data in the pen, then uploading the data from the pen to a computer for making a purchase (figures 4, 5 and 9). An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous, only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process (In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)). Applicant claims "interacting with the form via a sensing device". In the Specification (Specification, pages 73-80), Applicant describes a user printing a page with interactive components (e.g. "buy" button) that allows the user to place an order by drawing on the printed page. Clearly, to one of ordinary skill and by Applicant's own admission (Specification, page/line 24/3-26/16), such a method requires a special server and printer (i.e. netpage, netserver) for delivering and printing said page.

Applicant also describes interacting with various forms (e.g. checkout, product specification page) and digital applications (e.g. shopping cart), however it is not clear to one of ordinary skill whether this is performed offline, online or a mixture of the two (Specification, page/line 78/5-80/10). Therefore, one attempting to make or use Applicant's method would not be able to do so at least because said "interacting" step is not well-defined in the Specification.

Buckley et al. teach a pen that interacts with a form and generates data based on a reference point, sensing device movement and position (figures 1, 4, 5, 8 and 9) and a computer for receiving said data (4, 5, and 9).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-59 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1, 4, 5, 29, 32, 33, and 49 are dedicated to online purchasing using a "sensing device". Specifically, the claims recite interactions between a form and a pen. However, the Applicant's Disclosure is silent regarding the use of any other sensing device other than said pen when a customer desires to order goods and services online (Specification, page 73, lines 21-26; page 79, lines 16-21).

Claims 2, 3, 6-28, 30, 31, 34-48 and 50-59 are also rejected as they depend from claims 1, 4, 5, 29, 32, 33, or 49

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 4, 5, 29, 32, 33, or 49 teach an online purchasing system using forms (Specification, page/line 73/21-81/19). The Applicant teaches the forms as "paper" or "netpages" (i.e. interactive printed pages) (Specification, page 15/8-16/10; page 75, lines 3-15) and a user makes a purchase using a mixture of offline and online processing. However, it is not clear to one of ordinary skill when a user is offline or on (Specification, page/line 73/21-81/19; claims 1, 4, 5,

29, 32, 33 and 49) therefore, the scope of the Applicant's invention is not apparent.

Claims 2, 3, 6-28, 30, 31, 34-48 and 50-59 are also rejected as they depend from claims 1, 4, 5, 29, 32, 33, or 49

7. Claims 1-59 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: a netpage application running on a netpage server, downloading and printing a netpage from the netpage server, and a customer interacting with a netpage to order goods and services (Specification, figure 2; page 78, lines 25-28; page 79, lines 4-10 and 16-21)

Claims 2, 3, 6-28, 30, 31, 34-48 and 50-59 are also rejected as they depend from claims 1, 4, 5, 29, 32, 33, or 49.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 29-37, 41, 42, and 46 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Buckley et al., U.S. Patent No. 6,446,871.

As per claims 29-37, 41, 42, and 46 Buckley et al. teach a method and system for enabling online purchasing comprising:

- a form (which includes all required information relating to the purchase transaction) containing information (that relates to an item to be purchased and order acceptance) and including coded data (substantially invisible) indicative of an identity of the form and a plurality of mapped locations on the form (figures 1, 4, 5 and 7-9)
- receiving in a computer system, indicating data from a sensing device (with a nib) regarding the identity of the form, and a position of the sensing device relative to the form, and when placed in a position relative to the form, sensing the indicating data using at least some of the coded data (figures 1, 4, 5 and 7-9; column 4, lines 55-61; column/line 10/65-11/6)
- identifying in the computer system and from the indicating data, at least one parameter relating to the purchasing transaction (figures 1, 4, 5 and 7-9; column 3, lines 10-41; column/line 5/10-6/13)

- wherein the parameter is associated with a zone and identifying in the computer system and from the zone relative to which the sensing device is located said parameter (figures 1, 4, 5 and 7-9)
- wherein said parameter is an action (or option)parameter (e.g. purchase information, selecting an item for purchase, a quantity of an item, viewing a shopping cart and submitting an order) and effecting an operation in said computer system using said action (or option) parameter (figures 1, 4, 5 and 7-9; column/line 5/10-6/13)
- wherein said coded data is superimposed with a visual graphic, the visual graphic relating to the parameter associated with the coded data (figure 1; column 5, lines 8-38)
- receiving, and interpreting, in the computer system data regarding movement of the sensing device using at least some of the coded data (figures 1, 4 and 5)
- the computer system sensing a hand drawn mark using the sensing device (figures 1, 4, 5 and 7-9)

Buckley et al. teach a pen that interacts with a form and generates data based on a reference point, sensing device movement and position (figures 1, 4, 5, 8 and 9) and a computer for receiving said data (4, 5, and 9).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-10, 19, 20-23, 25, 28, 44, and 48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al., U.S. Patent No. 6,446,871 in view of Walkingshaw et al., U.S. Patent No. 5,488,423.

As per claims 1-10, 19 and 20, Buckley et al. teach a method and system for enabling online purchasing comprising:

- a form (which includes all required information relating to the purchase transaction) containing information (that relates to an item to be purchased and order acceptance) and including coded data (substantially invisible) indicative of an identity of the form and a plurality of mapped locations on the form (figures 1, 4, 5 and 7-9)
- receiving in a computer system, indicating data from a sensing device (with a nib) regarding the identity of the form, and a position of the sensing device relative to the form, and when placed in a position relative to the form, sensing the indicating data using at least some of

the coded data (figures 1, 4, 5 and 7-9; column 4, lines 55-61;
column/line 10/65-11/6)

- identifying in the computer system and from the indicating data, at least one parameter relating to the purchasing transaction (figures 1, 4, 5 and 7-9; column 3, lines 10-41; column/line 5/10-6/13)
- wherein the parameter is associated with a zone and identifying in the computer system and from the zone relative to which the sensing device is located said parameter (figures 1, 4, 5 and 7-9)
- wherein said parameter is an action (or option) parameter (e.g. purchase information, selecting an item for purchase, a quantity of an item, viewing a shopping cart and submitting an order) and effecting an operation in said computer system using said action (or option) parameter (figures 1, 4, 5 and 7-9; column/line 5/10-6/13)
- wherein said coded data is superimposed with a visual graphic, the visual graphic relating to the parameter associated with the coded data (figure 1; column 5, lines 8-38)
- receiving, and interpreting, in the computer system data regarding movement of the sensing device using at least some of the coded data (figures 1, 4 and 5)
- the computer system sensing a hand drawn mark using the sensing device (figures 1, 4, 5 and 7-9)

Buckley et al. teach a pen that interacts with a form and generates data based on a reference point, sensing device movement and position (figures 1, 4, 5, 8 and 9) and a computer for receiving said data (4, 5, and 9). However, Buckley et al. do not specifically recite the source of the form. Walkingshaw et al. teach an apparatus for printing coupons on a customer premises (abstract; figure 3). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Buckley et al. and Walkingshaw et al. in order to allow users to receive discounts on ordered goods by scanning product data on printed matter ('871, column 4, lines 40-47; column 11, lines 36-44 and 55-58) such as a coupon ('423, figure 3; column 4, lines 56-65).

As per claims 21-23, 25, 28, 44, 45, 48-51, Buckley et al., teach a method and system for conducting online purchases comprising a sensing device interacting with a form for reading and transmitting parameter data to a computer system (figures 1, 4, 5, and 7-9; column 5, lines 29-38). Buckley et al. do not specifically recite printing forms. However, electronically or manually distributing, downloading, printing and copying order forms are old and well-known and it would have been obvious to one of ordinary skill to allow users to access supplemental forms in case of mistakes or to place additional orders. Similarly, collecting and binding (e.g. staples, paper clips, rubber bands) forms are also well-known. Buckley et al. also teach detecting sensing device data using an accelerometer (column 12, lines 15-27).

12. Claims 11, 24 and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al., U.S. Patent No. 6,446,871, in view of Wolff et al., U.S. Patent No. 6,081,261, Bezos et al., U.S. Patent No. 5,727,163 and Walkingshaw et al., U.S. Patent No. 5,488,423.

As per claims 11, 24 and 38-40, Buckley et al., teach a method and system for conducting online purchases comprising a sensing device interacting with a form for reading and transmitting parameter data to a computer system (figures 1, 4, 5, and 7-9; column 5, lines 29-38). Walkingshaw et al. teach an apparatus for printing coupons on a customer premises (abstract; figure 3). However, neither Buckley et al. nor Walkingshaw et al. specifically recite parameter data as shipping address, shipping method, payment method or card type. Wolff et al. teach a form processing method where a sensing device is used to generate a corresponding electronic document from an off-line document (column 2, lines 50-56). Wolff et al. also teach automated form processing comprising generating electronic forms from a hard-copy original using a sensing device (abstract; column 2, lines 50-57) and form management where a form can be retrieved from an archive by means of a database search (column 3, 10-20). Bezos teaches order forms that require users to provide data such as shipping address, shipping method, payment method or card type. Therefore, it would have been obvious to combine the teachings of Buckley et al., Wolff et al., Bezos

and Walkingshaw et al. in order to more efficiently and accurately order products and services.

13. Claims 12-18, 26, 43 and 52-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al., U.S. Patent No. 6,446,871 in view of in view of Wolff et al., U.S. Patent No. 6,081,261, Thompson-Rohrlich, U.S. Patent No. 5,500,937 and Walkingshaw et al., U.S. Patent No. 5,488,423.

As per claims 12-18, 26, and 43, Buckley et al., teach a method and system for conducting online purchases comprising a sensing device interacting with a form for reading and transmitting parameter data to a computer system (figures 1, 4, 5, and 7-9; column 5, lines 29-38). Buckley et al. also teach detecting sensing device data, such as text, using an accelerometer (column 12, lines 15-27) and wirelessly transmitting sensing device data. Walkingshaw et al. teach an apparatus for printing coupons on a customer premises (abstract; figure 3). However, neither Buckley et al. nor Walkingshaw et al. specifically recite parameter data as shipping address, shipping method, payment method or card type. Wolff et al. teach a form processing method where a sensing device is used to generate a corresponding electronic document from an off-line document (column 2, lines 50-56) while Thompson-Rohrlich teaches entering handwritten text (e.g. authorization signature, quantity) data using a sensing device, for effecting an operation in a computer system (abstract; figures 1-3). Wolff et al.

also teach signature verification ('261, column 2, lines 57-61). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Buckley et al., Wolff et al., Thompson-Rohrlich and Walkingshaw et al. in order to more efficiently process orders by automating the order authorization function ('937, figures 1 and 2).

As per claims 52-59, Thompson-Rohrlich teach digital ink and biometric data (figures 2-10c). Wolff et al. teach biometric data such as pen tilt, pen force, or fingerprint data (column 2, lines 57-62; column/line7/5-8/67) and coded data as barcodes (macrodots, having corners, substantially invisible and provided with infrared absorbing media) (abstract; figures 5 and 6; column/line7/5-8/67), and Buckley et al. teach wireless sensing devices (column 4, lines 55-61; column 7, lines 20-42), printing on surfaces that are part of a product or package (figure 1; column 5, lines 9-36), and coded data as barcodes (macrodots, having corners, substantially invisible and provided with infrared absorbing media) (figures 1, 4, 5, 8 and 9; column 4, lines 55-61; column 7, lines 20-42).

14. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al., U.S. Patent No. 6,446,871 in view of Wolff et al., U.S. Patent No. 6,081,261.

As per claim 47, Buckley et al. teach a method and system for conducting online purchases comprising a sensing device interacting with a form for reading

and transmitting parameter data to a computer system (figures 1, 4, 5, and 7-9; column 5, lines 29-38). However, Buckley et al. do not specifically recite storing forms. Wolff et al. teach automated form processing comprising generating electronic forms from a hard-copy original using a sensing device (abstract; column 2, lines 50-57). Wolff et al. also teach form management where a form can be retrieved from an archive by means of a database search (column 3, 10-20). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Buckley et al. and Wolff et al. in order to allow users more efficiently access archived data.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

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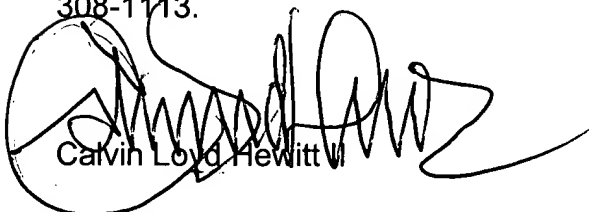
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(703) 746-5532 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application
should be directed to the Group receptionist whose telephone number is (703)

308-1113.



Calvin Lloyd Hewitt

March 29, 2005